

REMARKS

This Amendment is filed in response to the Final Office Action mailed Aug. 30th, 2005. All objections and rejections are respectfully traversed.

Claims 1-34 are in the case.

Claim 6 has been amended to correct a typographical error.

No claims have been added.

Examiner's Response to Arguments

At paragraphs 1-2 of the Final Office Action, the Examiner responded to the Applicant's arguments. While the Applicant thanks the Examiner for responding specifically, the Applicant respectfully asserts the Examiner's response and reasoning is improper in light of 35 U.S.C. §102. Specifically, the Examiner apparently attempts to combine subject matter allegedly "well-known to one of skill in the art" with the teachings of Orr, U.S. Patent No. 6,189,114, to support an anticipation rejection. Such combination of references is not proper under 35 U.S.C. §102.

The MPEP section 2131 describes the mandates of §102 stating:

"A claim is anticipated only if each and every element as set forth in the claim is found either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Accordingly, the lack of any explicit or inherent disclosure of the Applicant's claimed "removable nonvolatile memory device containing diagnostics code" by Orr may not be addressed by combining Orr with apparent Official Notice, in the context of a §102 rejection.

tion. The Applicant requests the Examiner withdraw such §102 rejection and issue another Non-Final Office Action.

Further, the Applicant respectfully requests the Examiner reconsider the Examiner's argument in paragraph 2 of the Office Action that a memory device soldered to a motherboard may be fairly characterized as "removable." The Examiner states:

For example, depending on how a ROM memory device is attached to a circuit board, it may be necessary to heat the connections in order to melt solder to remove the ROM... These two memory configurations are well-known in the art and describe how a non-volatile memory device may be removable.

The fact that with the enough tools, time, and effort, one can de-construct a circuit board does not make the circuit components on the board "removable" in a fair sense of the word. The Applicant posits that ROMs soldered to a circuit board are much better characterized as examples of non-removable components, and accordingly in no way anticipate the present claims.

Claim Rejections - 35 U.S.C. §102

At paragraph 3 of the Office Action, claims 1, 5, 7, 9-12, 16, 19, 24-27, and 30-31 were rejected under 35 U.S.C. §102(e) as anticipated by Orr, U.S. Patent No. 6,189,114, issued on Feb 13th, 2001 (hereinafter Orr).

The Applicant's claim 1, representative in part of the other rejected claims, sets forth:

1. A file server system for a computer having a processor, a memory coupled to the processor, and a system bus to which the processor and memory are coupled, the computer being configured to implement a file system, the file server system comprising:

(A) a storage operating system adapted to be executed by the processor;

(B) *a removable nonvolatile memory device coupled to the system bus, the removable nonvolatile memory device containing diagnostics code for the system;* and

(C) *a set of boot instructions resident in the filer server system* including instructions for executing a normal boot routine upon a power-on of the system, and *including instructions enabling the processor to identify the removable nonvolatile memory device and to load the diagnostics code into the memory* in response to a command to execute a diagnostics boot routine instead of the normal boot routine.

Orr describes a server (Fig. 1, item 40) remotely managed and controlled by a controlling computer (Fig. 1, item 10). *See Orr* at col. 4, lines 38-65. The server system 40 has a hardwired flash ROM (Fig. 2, item 50) containing a BIOS (item 60), a Power-on Self Test (POST) routine (item 62), and containing a diagnostic program (item 64), which when invoked, performs diagnostic testing of the server system. *See Id.* at col. 3, lines 2-6 and col. 5 lines 14-31. Remote management software on the controlling computer sets a flag in a CMOS (Fig. 1, item 51) internal to the server that triggers the POST routine to invoke the diagnostic program. *See Id.* col. 5, lines 56-59.

The Applicant respectfully urges that Orr is silent concerning the Applicant's claimed "*a removable nonvolatile memory device coupled to the system bus, the removable nonvolatile memory device containing diagnostics code for the system*" and "*a set of boot instructions resident in the filer server system ... including instructions enabling the processor to identify the removable nonvolatile memory device and to load the diagnostics code into the memory.*"

First, as discussed above, the Applicant novelly claims a ***removable nonvolatile memory device containing diagnostic code for the system***, while Orr teaches storing a diagnostic program on a conventional hardwired Flash ROM. Orr lacks any suggestion that it is possible, much less desirable, to remove the Flash ROM from the server. Accordingly, Orr does not anticipate this aspect of the claims.

Second, the Applicant novelly claims ***a set of boot instructions resident in the filer server system ... including instructions enabling the processor to identify the removable nonvolatile memory device***. Since Orr lacks any suggestion of a removable device, Orr necessarily lacks any set of instructions for enabling identification of such a device. While the Examiner points to col. 5, lines 56-59 of Orr for this claimed feature, such lines instead describes a Power-on Self Test (POST) routine (Fig 2, item 62) that is located on the same ROM (Fig 2, item 50) as Orr's diagnostic program (Fig 2, item 64). Such a routine stored on the same ROM as the diagnostic code does not show ***a set of boot instructions resident in the filer server system ... including instructions enabling the processor to identify the removable nonvolatile memory device***.

Accordingly, the Applicant respectfully urges that Orr is legally insufficient to anticipate the present claims under 35 U.S.C. §102(e) because of the absence of the Applicant's claimed novel "***a removable nonvolatile memory device coupled to the system bus, the removable nonvolatile memory device containing diagnostics code for the system***" and "***a set of boot instructions resident in the filer server system ... including instructions enabling the processor to identify the removable nonvolatile memory device and to load the diagnostics code into the memory.***"

Claim Rejections - 35 U.S.C. §103

At paragraph 4 of the Office Action, claims 2-4, 8, 13-15, 17-18, 20-23, 28-29, and 32-33 were rejected under 35 U.S.C. §103(a) as obvious in light of Orr, U.S. Patent No. 6,189,114, issued on Feb 13th, 2001 (hereinafter Orr), in view of Aguilar et al., U.S. Patent No. 6,785,807, issued on Aug. 31st, 2004 (hereinafter Aguilar)

The Applicant respectfully notes that claims 2-4, 8, 13-15, 17-18, 20-23, 28-29, and 32-33 are all dependent claims that depend from independent claims that are believed to be in condition for allowance.

Accordingly, claims 2-4, 8, 13-15, 17-18, 20-23, 28-29, and 32-33 are also believed to be in condition for allowance.

At paragraph 5 of the Office Action, claim 6 was rejected under 35 U.S.C. §103(a) as obvious in light of Orr, in view of Hitz et al., U.S. Patent No. 5,963,962, issued on October 5th, 1999 (hereinafter Hitz)

The Applicant's claim 6 sets forth:

6. A file server system for a computer having a processor, a memory coupled to the processor, and a system bus to which the processor and memory are coupled, the computer being configured to implement a file system, the file server system comprising:

(A) a storage operating system adapted to be executed by the processor;

(B) *a removable nonvolatile memory device coupled to the system bus, the removable nonvolatile memory device containing diagnostics code for the system;*

(C) *a set of boot instructions resident in the filer server system including instructions for executing a normal boot routine upon a power-on of the system, and including instructions enabling the processor to identify the removable nonvolatile memory device and to load the diag-*

nostics code into the memory in response to a command to execute a diagnostics boot routine instead of the normal boot routine;

(D) a storage adapter coupled to the system bus;

(E) at least one storage disk coupled to the storage adapter and containing files served by the operating system; and

(F) a plurality of storage disks coupled to the storage adapter and data on the disks being stored in a write anywhere file layout system.

Hitz discloses a file system, and describes a method of using inodes and snapshots to assist in maintaining consistency points.

The Applicant respectfully urges that both Orr and Hitz are silent concerning the Applicant's claimed "*a removable nonvolatile memory device coupled to the system bus, the removable nonvolatile memory device containing diagnostics code for the system*" and "*a set of boot instructions resident in the filer server system ... including instructions enabling the processor to identify the removable nonvolatile memory device and to load the diagnostics code into the memory.*"

As discussed above, Orr is silent concerning a *removable nonvolatile memory device containing diagnostic code for the system* and *a set of boot instructions resident in the filer server system* enabling a processor to identify such a removable device. Hitz merely discloses a file system using inodes and snapshots and is similarly silent concerning such claimed features.

Accordingly, the Applicant respectfully urges that the combination of Orr and Hitz is legally insufficient to make obvious the present claims under 35 U.S.C. §103 because of the absence from both references of the Applicant's claimed novel "*a removable nonvolatile memory device coupled to the system bus, the removable nonvolatile memory device containing diagnostics code for the system*" and "*a set of boot instructions resident in the filer server system ... including instructions enabling the processor to*

identify the removable nonvolatile memory device and to load the diagnostics code into the memory.”

In the event that the Examiner deems personal contact desirable in disposition of this case, the Examiner is encouraged to call the undersigned attorney at (617) 951-3078.


All independent claims are believed to be in condition for allowance.

All dependent claims are believed to be dependent from allowable independent claims.

The Applicant respectfully solicits favorable action.

Please charge any additional fee occasioned by this paper to our Deposit Account No. 03-1237.

Respectfully submitted,



James A. Blanchette
Reg. No. 51,477
CESARI AND MCKENNA, LLP
88 Black Falcon Avenue
Boston, MA 02210-2414
(617) 951-2500